

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



International Patent Application of

Francois SCHUTZE et al.

Application No.: 10/532,114

International Filing Date: April 21, 2005

For: Pharmaceutical Composition Combining
Tenatoprazole and a Histamine H2-
Receptor Antagonist

) Mail Stop PCT

) Group Art Unit:

) Examiner:

) Confirmation No.:

RENEWED SUBMISSION UNDER 37 CFR § 1.42

Attn: Office of PCT Legal Administration
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Decision on Declaration mailed on 19 June 2006 (a copy of which is attached), it is respectfully requested that the attached executed declarations be accepted.

In this regard, Applicants submit herewith two complete, separately executed declarations. Applicants note that the first complete copy contains the signatures of the first five named inventors and the second complete copy contains the signature of the sixth named inventor.

With regard to the deceased inventor Alain Taccon, pursuant to 37 C.F.R. §1.42 and MPEP § 409.01(a), Nathalie Taccon, who is Alain Taccon's wife, signed on his behalf as the sole heir and legal representative to Alain Taccon.

To clarify, the citizenship, residence and mailing address provided in the executed declaration applies to deceased inventor Alain Taccon and to his wife and sole heir and legal representative Nathalie Taccon.

As such, the deceased inventor is as follows:

Alain Taccon
9, avenue de Villiers
F-78150 Le Chesnay
France

The wife of and sole heir and legal representative to Alain Taccoen is as follows:

Nathalie Taccoen
9, avenue de Villiers
F-78150 Le Chesnay
France

Accordingly, the information provided in the executed declaration, which Nathalie Taccoen executed on Alain Taccoen's behalf, is applicable to both the deceased inventor Alain Taccoen and his wife, sole heir and legal representative, Nathalie Taccoen.

Therefore, the attached executed declarations provide the citizenship, residence and mailing address of both the deceased inventor and of the heir/legal representative. Thus, it is respectfully submitted that the executed declarations submitted herewith satisfy the requirements under 37 C.F.R. § 1.42, and it is respectfully requested that the executed declarations be accepted.

If there are any questions regarding this submission, please contact the undersigned.

Respectfully submitted,

BUCHANAN INGERSOLL PC

By: M. M. Haydt Reg No. 45,774
for: Teresa Stanek Rea
Registration No. 30,427

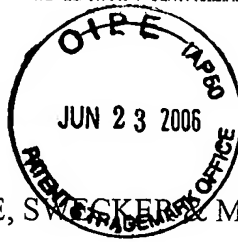
P.O. Box 1404
Alexandria, Virginia 22313-1404
(703) 836-6620

Date: June 23, 2006



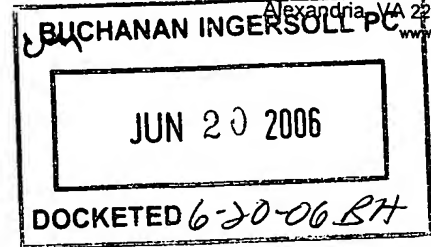
19 JUN 2006

UNITED STATES PATENT AND TRADEMARK OFFICE



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ALEXANDRIA VA 22313-1404

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov



In re Application of: SCHUTZE, Francois, et al. :
U.S. Application No.: 10/532,114 :
PCT No.: PCT/FR2003/003124 :
International Filing Date: 21 October 2003 :
Priority Date: 21 October 2002 :
Attorney Docket No.: 1032013-000119 :
For: PHARMACEUTICAL :
COMPOSITION COMBINING :
TEATOPRAZOLE AND A :
HISTAMINE H2-RECEPTOR :
ANTAGONIST :

DECISION REGARDING
SUBMISSION UNDER
37 CFR 1.42

Missing Parts Due 8-19-06

URGENT

This communication is issued in response to applicants' submission on 03 April 2006 of a declaration executed on behalf of deceased inventor Alain TACCOEN by his heir and legal representative Nathalie TACCOEN, which has been treated as a submission under 37 CFR 1.42. No petition fee is required.

BACKGROUND

On 21 October 2003, applicants filed international application PCT/FR2003/003124. The application claimed a priority date of 21 October 2002 and designated the United States. On 06 May 2004, the International Bureau (IB) communicated a copy of the international application to the United States Patent and Trademark Office (USPTO). The deadline for submission of the basic national fee was thirty months from the priority date, i.e., 21 April 2005.

On 21 April 2005, applicants filed a Transmittal Letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee and an English translation of the international application.

On 07 February 2006, the United States Designated/Elected Office (DO/EO/US) mailed a Notification Of Missing Requirements (Form PCT/DO/EO/905) indicating that an oath or declaration acceptable under 37 CFR 1.497 and the surcharge for filing the oath or declaration later than thirty months after the priority date were required.

On 03 April 2006, applicants filed a response to the Notification Of Missing Requirements that included payment of the required surcharge and a declaration executed by the surviving inventors and on behalf of deceased inventor Alain TACCOEN by his heir and legal

representative Nathalie TACCOEN. This declaration is considered below under 37 CFR 1.42 and 1.497.

DISCUSSION

37 CFR 1.42 states in part:

In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent.

37 CFR 1.497(b)(2) states:

If the person making the oath or declaration or any supplemental oath or declaration is not the inventor (§§ 1.42, 1.43, or 1.47) the oath or declaration shall state the relationship of the person to the inventor, and, upon information and belief, the facts which the inventor would have been required to state. If the person is the legal representative of a deceased inventor, the oath or declaration shall also state that the person is a legal representative and the citizenship, residence, and mailing address of the legal representative.

Pursuant to 37 CFR 1.497(b)(2), the declaration must provide the citizenship, mailing address, and residence information for the legal representative and the name and citizenship of the deceased inventor. Here, the filed declaration does not comply with 37 CFR 1.497(b)(2) in that it does not provide separate citizenship information for the deceased inventor.

In addition, the declaration filed 03 April 2006 (which consists of one copy of pages "1" and "2" and two different copies of page "3") appears to be a compilation of two separately executed declarations, and as such is not acceptable under 37 CFR 1.497. See MPEP § 201.03(II)(B): "Where individual declarations are executed, they must be submitted as individual declarations rather than combined into one declaration."

Because the filed declaration does not include all the information required by 37 CFR 1.497(b)(2) and appears to be a compilation of multiple declarations, the declaration cannot be accepted under 37 CFR 1.42 and 37 CFR 1.497.

CONCLUSION

The 03 April 2006 submission under 37 CFR 1.42 is **REJECTED** without prejudice.

Applicants have **TWO (2) MONTHS** from the mail date this communication to submit a proper response under 37 CFR 1.42 and 1.497. Failure to file a proper and timely response will result in abandonment. Extensions of time are available under 37 CFR 1.136(a).

A proper response must include an oath or declaration executed on behalf of the deceased inventor by his legal representative and containing all the information required under 37 CFR 1.497, including, as discussed above, the citizenship, residence, and mailing address of the legal representative and the name and citizenship of the deceased inventor. Applicants must also provide complete copies of the declarations executed by the surviving inventors (rather than the compilation filed 03 April 2006).

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



Richard M. Ross
Attorney Advisor
Office of PCT Legal Administration
Telephone: (571) 272-3296
Facsimile: (571) 273-0459

COMBINED DECLARATION AND POWER OF ATTORNEY FOR UTILITY OR DESIGN PATENT APPLICATION



As a below named inventor, I hereby declare that:

My residence, post office address and citizenship are as stated below next to my name;

I believe I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled:

**PHARMACEUTICAL COMPOSITION COMBINING TENATOPRAZOLE AND A
HISTAMINE H2-RECEPTOR ANTAGONIST**

the specification of which (check only one item below):

- ☐ is attached hereto.
- ☒ was filed as United States Patent application Number 10/532,114
on April 21, 2005 and was amended on ____ (if applicable).
- ☐ was filed as PCT International application Number _____
on _____ and was amended on _____
(if applicable).

I hereby state that I have reviewed and understand the contents of the above-identified specification, including the claims, as amended by any amendment referred to above.

I acknowledge the duty to disclose to the Office all information known to me to be material to patentability as defined in Title 37, Code of Federal Regulations, § 1.56.

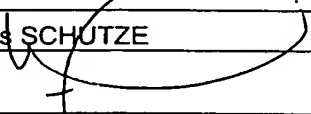
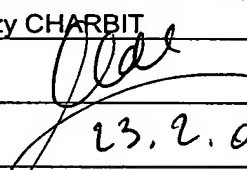
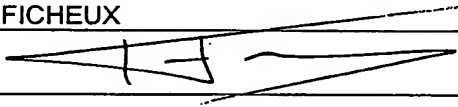
I hereby claim foreign priority benefits under Title 35, United States Code, §§ 119 (a)-(d), 172 or 365(a) of any foreign application(s) for patent or inventor's certificate or of any international (PCT) application(s) designating at least one country other than the United States of America listed below and have also identified below any foreign application(s) for patent or inventor's certificate or any PCT international (PCT) application(s) designating at least one country other than the United States of America filed by me on the same subject matter having a filing date before that of the application(s) of which priority is claimed:



| PRIOR FOREIGN/PCT APPLICATION(S) AND ANY PRIORITY CLAIMS UNDER 35 U.S.C. §§119(a)-(d), 172 or 365(a): | | | | |
|---|--------------------|--------------------------------|---|----|
| COUNTRY (if PCT, indicate "PCT") | APPLICATION NUMBER | DATE OF FILING (MM/DD/YYYY) | PRIORITY CLAIMED UNDER 35 U.S.C. §§119, 172 OR 365(a) | |
| | | | Yes | No |
| PCT | PCT/FR2003/003124 | 10-21-2003 | X | |
| France | 02/13114 | 10-21-2002 | X | |
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I hereby appoint the attorneys and agents associated with the following PTO Customer Number of Buchanan Ingersoll PC (including attorneys from Burns, Doane, Swecker & Mathis) to prosecute said application and to transact all business in the Patent and Trademark Office connected therewith and to file, prosecute and transact all business in connection with international applications directed to said invention:

Customer Number **2 1 8 3 9**

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

| | |
|--|--|
| FULL NAME OF SOLE OR FIRST INVENTOR | François SCHUTZE |
| Signature |  |
| Date | 22.02.2006 |
| Residence (City, State, Country) | Saint-Nom-La-Bretèche, France |
| Citizenship | French |
| Mailing Address | 4, rue Charles Baudelaire, |
| City, State, ZIP, Country | F-78860 Saint-Nom-La-Bretèche, France |
| FULL NAME SECOND INVENTOR, IF ANY | Suzy CHARBIT |
| Signature |  |
| Date | 23.2.06 |
| Residence (City, State, Country) | Créteil, France |
| Citizenship | French |
| Mailing Address | Bât. 7, 25, Square Edison |
| City, State, ZIP, Country | F-94000 Créteil, France |
| FULL NAME OF THIRD INVENTOR, IF ANY | Hervé FICHEUX |
| Signature |  |
| Date | 23 February 2006 |
| Residence (City, State, Country) | Nogent-Sur-Marne, France |
| Citizenship | French |
| Mailing Address | 26bis, boulevard de Strasbourg |
| City, State, ZIP, Country | F-94130 Nogent-Sur-Marne, France |

| | |
|--|--|
| FULL NAME OF FOURTH INVENTOR, IF ANY | Michel HOMERIN |
| Signature |  |
| Date | 21.02.2006 |
| Residence (City, State, Country) | Courcouronnes, France |
| Citizenship | French |
| Mailing Address | 9, Villa des Roseraies |
| City, State, ZIP, Country | F-91080 Courcouronnes, France |
| FULL NAME OF FIFTH INVENTOR, IF ANY | Alain TACCOEN, Deceased |
| | Executed by Nathalie Taccoen, wife of and heir and legal representative to Alain Taccoen |
| Signature |  |
| Date | 17.02.2006 |
| Residence (City, State, Country) | Le Chesnay, France |
| Citizenship | French |
| Mailing Address | 9, avenue de Villiers |
| City, State, ZIP, Country | F-78150 Le Chesnay, France |
| FULL NAME OF SIXTH INVENTOR, IF ANY | Yoshio INABA |
| Signature | |
| Date | |
| Residence (City, State, Country) | Chuo-Ku, Tokyo, Japan |
| Citizenship | Japan |
| Mailing Address | 2-2-6 Nihonbashi-Honcho |
| City, State, ZIP, Country | Chuo-Ku, Tokyo 103-8405, Japan |
| FULL NAME OF SEVENTH INVENTOR, IF ANY | |
| Signature | |
| Date | |
| Residence (City, State, Country) | |
| Citizenship | |
| Mailing Address | |
| City, State, ZIP, Country | |

COMBINED DECLARATION AND POWER OF ATTORNEY FOR UTILITY OR DESIGN PATENT APPLICATION



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My residence, post office address and citizenship are as stated below next to my name;

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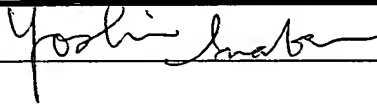
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| COUNTRY (if PCT, indicate "PCT") | APPLICATION NUMBER | DATE OF FILING (MM/DD/YYYY) | PRIORITY CLAIMED UNDER 35 U.S.C. §§119, 172 OR 365(a) | |
| | | | Yes | No |
| PCT | PCT/FR2003/003124 | 10-21-2003 | X | |
| France | 02/13114 | 10-21-2002 | X | |
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| | |
|--|---------------------------------------|
| FULL NAME OF SOLE OR FIRST INVENTOR | François SCHUTZE |
| Signature | |
| Date | |
| Residence (City, State, Country) | Saint-Nom-La-Bretèche, France |
| Citizenship | French |
| Mailing Address | 4, rue Charles Baudelaire, |
| City, State, ZIP, Country | F-78860 Saint-Nom-La-Bretèche, France |
| FULL NAME SECOND INVENTOR, IF ANY | Suzy CHARBIT |
| Signature | |
| Date | |
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| FULL NAME OF FOURTH INVENTOR, IF ANY | Michel HOMERIN |
| Signature | |
| Date | |
| Residence (City, State, Country) | Courcouronnes, France |
| Citizenship | French |
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| City, State, ZIP, Country | F-91080 Courcouronnes, France |
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| | Executed by Nathalie Taccoen, wife of and heir and legal representative to Alain Taccoen |
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| Citizenship | French |
| Mailing Address | 9, avenue de Villiers |
| City, State, ZIP, Country | F-78150 Le Chesnay, France |
| FULL NAME OF SIXTH INVENTOR, IF ANY | Yoshio INABA |
| Signature  | |
| Date | |
| Residence (City, State, Country) | Chuo-Ku, Tokyo, Japan |
| Citizenship | Japan |
| Mailing Address | 2-2-6 Nihonbashi-Honcho |
| City, State, ZIP, Country | Chuo-Ku, Tokyo 103-8405, Japan |
| FULL NAME OF SEVENTH INVENTOR, IF ANY | |
| Signature | |
| Date | |
| Residence (City, State, Country) | |
| Citizenship | |
| Mailing Address | |
| City, State, ZIP, Country | |